

**REMARKS**

By this amendment, claims 1-33 are pending, in which claim 19 is currently amended. No new matter is introduced.

The Office Action mailed May 7, 2004 rejected claims 1-4, 6-12, 14-15, 19-22, 24-28 and 30 as obvious under 35 U.S.C. § 103 based on *Nakatsu et al.* (US 5,787,151) in view of *Taskett* (US 5,923,734), claims 5, 13, 23 and 29 as obvious under 35 U.S.C. § 103 based on *Taskett* in view of *Cho* (US 5,978,452), *Bruno* (US 5,991,380) and further in view of *Nguyen* (US 5,815,561), and claims 16 and 31 as obvious under 35 U.S.C. § 103 based on *Taskett* in view of *Nakatsu et al.*

As an initial matter, Applicants wish to point out an apparent omission in the Office Action on page 11 regarding the rejection of claims 5, 13, 23 and 29. Item 5, first paragraph states that these claims “are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Cho in view of Bruno and in further view of Nguyen et al.” However, this statement is inconsistent with the subsequent paragraph, which states “Regarding claims 5, 13, 23 and 29, **Nakatsu** and Taskett as applied in claim 3....” Also, the remaining explanation of the rejection refers again to *Nakatsu et al.* Therefore, Applicants’ present response assumes the rejection is based on the combination of *Nakatsu et al.*, *Taskett*, *Cho*, *Bruno*, and *Nguyen*.

To reduce issues for Appeal, independent claim 19 has been amended to recite “a data storage system storing data corresponding to a prepaid telephone calling card and to a personal greeting related to said pre-paid telephone calling card, **wherein said personal greeting was recorded during a calling card setup call.**”

In the several obviousness rejections, the Examiner relies on the newly applied reference of *Nakatsu et al.* Applicants respectfully submit that these rejections are unsustainable in that for the Examiner to properly rely on a reference, the reference must be analogous, pursuant to MPEP

§ 2141.01 (a). While a reference in a § 102 anticipation may be non-analogous, a base reference for a § 103 reference must be analogous, that is it must relate to the problems and causes of the present invention, *Corning Glass Works v. Sumitomo Electric* (CAFC, 1989) 9 USPQ2nd 1962.

*Nakatsu et al.* is directed to a telephony based electronic voice greeting card service (see Abstract) for delivering a message containing a selected greeting over a telephone network (col. 1: 12-15). *Nakatsu et al.* (col. 1: 16-45) recognizes the problems associated with traditional greeting cards, stating the following (*Emphasis Added*):

**Traditional greeting cards are paper based products on which textual greetings that relate to special occasions are printed, for example, humorous wishes for birthdays, seasonal wishes at Christmas, "get well soon" wishes when a person is struck by illness and the like. Typically, a person aware of the pending special occasion must travel to a department store or specialty outlet to purchase an appropriate greeting card, write a personal message on the card, address its envelop with the postal address of the intended recipient, obtain and apply sufficient postage to the envelope, and lastly depend upon the postal service for timely delivery of the card.**

The greeting card industry has recently adopted some electronic technologies. Kiosks that allow a user to produce personalized greeting cards dynamically are in use today. These kiosk typically include a touch-sensitive screen on which a hierarchy of menus relating to special occasions and various corresponding greetings are presented. The user cycles through the menus and alternative greetings offered to select a preferred greeting which the kiosk subsequently prints onto paper. Also, greeting cards exist that incorporate voice chip technology within the card thereby allowing the purchaser to record a personal voice message. **These existing technologies, however, still relate to paper based greeting cards which suffer from inherent disadvantages, for instance, inconvenience in terms of traveling to specific retail outlets and reliance on manual delivery.** Moreover, the variant of the traditional card utilizing the voice chip technology is rather expensive.

As evident from the above passage, *Nakatsu et al.* seeks to address the problems with paper based greeting cards, which involve many manual processes. By contrast, the claimed invention has a field of endeavor associated with a "pre-paid telephone calling card." The only mention by *Nakatsu et al.* of anything remotely related to pre-paid telephone calling cards

involves a method of payment for the greeting card service (col. 2: 44-46). Therefore, one of ordinary skill in the art would not consult the *Nakatsu et al.*, which concerns problems with greeting cards, to address problems relating to pre-paid telephone calling cards. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986) and *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). In this particular instance, the field of greeting cards does not pertain to the field of pre-paid telephone calling cards. Additionally, the problems relating to paper based greeting cards are not pertinent to the Applicants' particular problem of pre-paid telephone calling cards.

The proposed modifications to the *Nakatsu et al.* system is technically without merit or support, further reinforcing that *Nakatsu et al.* is non-analogous art. The Office Action (page 3) acknowledges that *Nakatsu et al.* "fails to disclose the voice card as a pre-paid telephone calling card," necessarily relies on *Taskett*, which discloses a system for effectuating commercial transactions using a pre-paid instrument (see Abstract). As best as can be understood, the Office Action is suggesting that the voice card (i.e., greeting card) can be replaced with a pre-paid telephone calling card. This suggestion is technically nonsensical, and reveals the extraordinary measure the Examiner is taking to reconstruct the claims based on hindsight.

For motivation, the Office Action summarily concludes "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pre-paid telephone calling card with special greeting of Taskett in the voice card system and allow the receiver to call to retrieve the personal greeting left by the caller of Nakatsu." In drawing this conclusion, the Office Action has ignored the basic tenets of obviousness. In rejecting claim under 35 U.S.C.

§ 103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F. 2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S. Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). There is simply no suggestion in the art for the modification the Examiner is proposing, even assuming a reasonable technical reason can be contrived.

Furthermore, *Nakatsu et al.* is attempting to eliminate the use of a physical card (i.e., paper based greeting card), as explained earlier. Therefore, *Nakatsu et al.* teaches away the claimed invention, which recites use of a “telephone card.” It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

For the foregoing reasons, Applicants respectfully request withdrawal of the obviousness rejection over the *Nakatsu et al.* in view of *Taskett*, and urge the indication that independent claims 1, 10, 16, 19, 27 and 31 are allowable.

The rejection of dependent claims 2-4, 6-9, 11-12, 14-15, 17-18, 20-22 and 30 should likewise be withdrawn for at least the same reasons for the allowability of their respective independent claims. Additionally, these claims are also patentable on their own merits. For example, claim 3 recites “pre-paid telephone calling card includes **a quantity corresponding to a number of service units available to be used to make at least one call in relation to said pre-paid telephone calling card.**” To satisfy this feature, the Office Action cites col. 5, lines

30-45 of *Taskett*, explaining that “the user is prompted for additional information such as authorization code and the desired long distance phone number.” Applicants agree that *Taskett* indeed discloses a user being prompted for authorization code and the desired long distance phone number, but do not understand the relevance of this disclosure. For convenience, the cited passage is as follows (*Emphasis Added*):

In a preferred embodiment, visual indicia 202 comprises a photograph or drawing of a living or deceased person or celebrity such as Elvis Presley, Marilyn Monroe, James Dean, or the like. Upon dialing access phone number 140 and accessing the service provider network, a reproduction (e.g., recording) of the voice of the celebrity stored in the voice library or voice storage facility is played back to the user of card 100. **The voice of the celebrity may provide instructions on using telephone card 100 or may prompt the user for additional information such as authorization code 142 and the desired long distance phone number.** In the case of deceased celebrities, the voice for the instructions may be obtained by taking snippets or sound bites from taped interviews, movies, records, and other recordings. These voice snippets are then sorted and stored in the voice library until retrieved by the host computer.

The above passage is absolutely silent with respect to a “pre-paid telephone calling card” that includes “**a quantity corresponding to a number of service units,**” much less “**a number of service units available to be used to make at least one call in relation to said pre-paid telephone calling card.**” 35 U.S.C. § 132 requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified

early and the applicant can be given fair opportunity to respond.” Unfortunately, the Examiner’s only discussion of the claim features (of claim 3) is a vague reference to a seemingly irrelevant passage.


The other obviousness rejections involve the combination of *Nakatsu et al.* and *Taskett*. As proffered above, this combination is improper. The other secondary references of *Cho*, *Bruno*, and *Nguyen* do not negate this improper combination.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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